

REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the Office Action of June 26, 2007, the Examiner rejected claim 37, under 35 U.S.C §101 because the claimed invention is directed to non-statutory subject matter; and rejected claims 37-38, under 35 U.S.C. §103(a), as allegedly being unpatentable over Palcic '809 (U.S. Patent Pub. No. 2003-0004809 A1) in view of Lee '673 (U.S. Patent Pub. No. 2002-0161673 A1).

By this Amendment, claims 37 and 38 have been amended to provide a clearer presentation of the claimed subject matter and new claims 40-42 have been added. As such, claims 37-38 and 40-42 are still presented for examination, of which claims 37 and 38 are independent.

I. Non-Statutory Rejection of claim 37

Applicants have amended claim 37 to provide a clearer presentation of the claimed subject matter and respectfully submit that these amendments recite a claim directed to a computer readable medium storing thereon a program for causing the computer to perform as a portal site server being a part of a system operated by an insurance company to grant compensation to a user, and having a compensation-granting database; a URL rewriting unit; a history database; and a compensation-granting unit. Such elements and limitations are specific, substantial, and credible according to MPEP §2106, and produce a “useful result.” Such elements/steps also grant a compensation, which can be considered as a tangible result. Moreover, the elements and limitations as claimed are substantially repeatable or substantially produce the same result again and meets the requirement of the concrete result.

Accordingly, as the amended claimed features form a useful, tangible and concrete result, independent claim 37 has substantial practical applications, such as providing compensation (e.g., insurance) to a user who purchases a merchandise by electronic commerce. Accordingly, Applicant respectfully submits that amended claim 37 is statutory subject matter under 35 U.S.C. §101.

Applicant traverses the §103(a) rejections for the following reasons:

II. Rejections Under §103(a).

As noted above, independent claim 37 is directed to a computer readable medium storing thereon a program for causing the computer to perform as a portal site server being a part of a system operated by an insurance company to grant compensation to a user, and positively recites a compensation-granting database configured to store URL information of the member store in advance; a URL rewriting unit which receives a second URL of a web page upon a user's request, rewrites said second URL to be linked to said first URL if the second URL requested by the user is found in said URL information stored in the compensation-granting database, and transmits said rewritten URL to the user terminal; a history database for storing deal information including information related to the access to the portal site server by the user; and a compensation-granting unit for granting compensation to the user based on the deal information stored in the history database. These features are amply supported by the embodiments disclosed in the written description. (*See, e.g.*, Specification: par. [0064]-[0067]; par. [0120]-[0123]; and FIGS. 1 and 18).

Applicant respectfully submits that, despite the Examiner's contentions, none of the asserted references, whether taken alone or in reasonable combination, teach or suggest each and every element of claim 37, including the features identified above. In particular, Palcic '809 discloses a system and method for calculating and administering offering of equity grants and earned equity incentives to customers who consume products or services offered by a provider, based on several factors including the consumption of products and services by the customer (See paragraph [0009]). Palcic '809 (see FIG. 1) discloses a system in which transactions are performed between two entities such as merchant and customer/owner.

In contrast, the current invention discusses a system where transactions are performed among three entities, an insurance company, a member store and a user, i.e., among a portal site server, a member store web page, and a user terminal. The user accesses the insurance-providing portal site server to purchase merchandise from the member store web page. The insurance-providing portal site server authenticates the user and provides the user access to

the member store web page. Insurance is granted to the user by insurance-providing portal site server for purchasing the merchandise on the member store web page.

Specifically, the member store pays basic premium to the insurance company to insure merchandise sold at the member store, the user pays for the merchandise to the member store, and the insurance company, which operates the insurance-providing portal site server, grants insurance for purchasing the merchandise on the member store. Thereafter, the insurance company makes an insurance payment to the user when an accident or trouble occurs (*See, e.g.,* Specification: par. [0066]). The compensation paid by the insurance company, which operates the insurance-providing portal site server, to the user is based on the premium payment from the member stores. This concept is not discussed by Palcic '809.

Applicants submit that the remaining asserted reference, Lee '673, does nothing to cure the deficiencies of Palcic '809 noted above and fails in its own right to teach the combination of elements of independent claim 37. Thus, for at least these reasons, Applicant submits that none of the asserted references are capable of rendering claim 37 unpatentable. As such, claim 37 is clearly patentable.

Furthermore, because independent claim 38 recites patentable features similar to claim 37, claim 38 is patentable for at least the reasons presented relative to claim 37. And, because claims 40-42 depend from claim 37, claims 40-42 are patentable at least by virtue of dependency as well as for their additional recitations. Accordingly, the immediate withdrawal of the rejections under §103(a) is respectfully requested.

III. Conclusion.

All matters having been addressed and in view of the foregoing, Applicant respectfully requests the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant's representative remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains in issue which the Examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number **03-3975**. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

**PILLSBURY WINTHROP
SHAW PITTMAN LLP**



E. Rico HERNANDEZ
Reg. No. 47641
Tel. No. 703.770.7788
Fax No. 703 770.7901

Date: September 26, 2007
P.O. Box 10500
McLean, VA 22102
(703) 770-7900